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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,760	06/07/2001	Markus Scheuber	34183/233887	2221

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ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER

CULLER, JILL E

ART UNIT PAPER NUMBER

2854

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/876,760

Applicant(s)

SCHEUBER ET AL.

Examiner

Jill E. Culler

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/078,914.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 4,681,348 to Mowry, Jr.

Mowry, Jr. shows a method of providing text on a printed surface, 20, of a printed product, 10, comprising the steps of applying a partially transparent contrast panel, 40, to the printed surface by printing the contrast panel onto the printed surface, with the contrast panel allowing the printed surface of the printed product, 20, to be seen therethrough, see Fig. 3, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, wherein the step of forming information within or on the contrast panel comprises forming blank areas within the contrast panel, with the blank areas forming the information. See column 1, lines 49-55 and Fig. 3 in particular.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by "A Century of Comics" (as discussed in the article entitled "1933: The First Comic Book" by Mike Benton)

The first paragraph of the article describes the comic books as "four-color, tabloid-sized" magazines. These magazines would therefore have been produced using a four-color printing process, as discussed in the enclosed article "Understanding Color" by John C. Lee.

Using this information, it can be seen that "A Century of Comics" shows a method of providing text on a printed surface of a printed product, consider the first layer of colored printing for the balloon in the cover illustration, comprising the steps of applying a partially transparent contrast panel to the printed surface by printing the contrast panel onto the printed surface, with the contrast panel allowing the printed surface of the printed product to be seen therethrough, consider the second layer of color printing for the balloon, using partially transparent ink so that the original layer of printing can be seen through the second layer, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, consider the text on the surface of the balloon, wherein the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of U.S. Patent No. 2,084,026 to Gurwick.

Mowry, Jr. teaches all that is claimed, as in the above rejection of claims 1 and 3 except that the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

Gurwick teaches a method of forming information, 18, within or on a contrast panel, 16, by printing the information onto the contrast panel. See page 3, lines 9-21.

It would have been obvious to one having ordinary skill in the art at the time of the invention to form information on the contrast panel of Mowry, Jr. by printing the information, as taught by Gurwick, in order to provide additional contrast between the panel and the information.

6. Claims 5, 7-8, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. as applied to claims 1 and 3 above, and further in view of U.S. Patent No. 4,983,990 to Fröhlich.

Mowry Jr. teaches all that is claimed, as in the above rejection of claims 1 and 3, except for providing text on each of a plurality of printed products by conveying the

printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing steps of Braun et al. and Katzman with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

7. Claims 6, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of Fröhlich as applied to claims 5, 7-8, 10-11 and 13 above, and further in view of Gurwick.

Mowry Jr. and Fröhlich teach all that is claimed, as in the above rejection of claims 5, 7-8, 10-11 and 13, except that the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

Gurwick teaches a method of forming information, 18, within or on a contrast panel, 16, by printing the information onto the contrast panel. See page 3, lines 9-21.

It would have been obvious to one having ordinary skill in the art at the time of the invention to form information on the contrast panel of Mowry, Jr., as combined with Fröhlich by printing the information, as taught by Gurwick, in order to provide additional contrast between the panel and the information.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of Fröhlich as applied to claims 5, 7-8, 10-11 and 13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.

Mowry, Jr. and Fröhlich teach all that is claimed, as in the above rejection of claims 5, 7-8, 10-11 and 13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the invention of Mowry, Jr. and Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

9. Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A Century of Comics", as applied to claims 1-2 above, and further in view of U.S. Patent No. 4,983,990 to Fröhlich.

"A Century of Comics" teaches all that is claimed, as in the above rejection of claims 1-2, except for providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing method of "A Century of Comics" with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over "A Century of Comics" in view of Fröhlich as applied to claims 5-13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.



"A Century of Comics" and Fröhlich teach all that is claimed, as in the above rejection of claims 5-13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the method of "A Century of Comics", as modified by Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

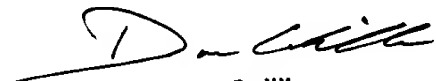
### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (703) 308-1413. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

jec



Dan Collila  
Primary Examiner  
Art Unit 2854